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**OFFICE OF PETITIONS**

In re Application of	:	
Hiroshi Sumiyama et al.	:	
Application No. 09/955,963	:	DECISION ON PETITION
Filed: September 20, 2001	:	
Attorney Docket Number:	:	
018775-842	:	
Title: IMAGE FORMING	:	
APPARATUS INCORPORATING NO	:	
IMAGE MEMORY WITH MEMORY	:	
RECALL FUNCTION	:	

This is a decision on the "petition to reset response date to office action based on failure to receive office action," which is properly treated as a petition under 37 C.F.R. §1.181, filed on March 21, 2006.

BACKGROUND

A non-final Office action was mailed October 4, 2005, which set a shortened statutory period for reply of three (3) months. With this petition, Petitioner has asserted that the non-final Office action was not received. Petitioner has included an amendment and a three-month extension of time, but has requested that the extension of time not be charged to his account due to the failure to receive the Office action.

A discussion follows.

RELEVANT PORTION OF THE MPEP

MPEP 711.03(c) sets forth, in part:

PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

Two additional procedures are available for reviving an application that has become abandoned due to a failure to reply to an Office Action: (1) a petition under 37 CFR 1.137(a) based upon unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.

See also 1156 O.G. 53 (October 25, 1993), which may be viewed at <http://www.uspto.gov/web/offices/com/sol/og/con/files/cons074.htm>.

Petitioner has not established non-receipt of Office action.  
Petitioner has included a statement that the Office

communication was not received by the Practitioner and he has attested to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. However, Petitioner has not provided a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed.

CONCLUSION

In view of the above, this petition must be **DISMISSED**.

Any request for reconsideration of this decision under 37 C.F.R. §1.181 must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The request for reconsideration should include a cover letter entitled "Renewed Petition under 37 C.F.R. 181," and should only address the deficiencies noted in this decision.

The renewed petition should display "Please deliver to Paul Shanoski, c/o Office of Petitions" in a prominent manner. Any renewed petition may be submitted by mail<sup>1</sup>, hand-delivery<sup>2</sup>, or facsimile<sup>3</sup>.

**The request to enter the amendment and charge the three-month extension of time to Petitioner's Deposit Account will be held in abeyance so as to afford Petitioner the opportunity to file a renewed petition. If Petitioner would prefer to have the extension of time charged to his Deposit Account, a response to this decision should be submitted with words to this effect.**

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Paul Shanoski  
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Office of Petitions  
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<sup>1</sup> Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

<sup>2</sup> Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

<sup>3</sup> (571) 273-8300 - please note this is a central facsimile number.